

REMARKS

Reconsideration of the application is respectfully requested for the following reasons:

1. Objections to Specification

These objections have been addressed by:

- amending pages 1 and 2 of the specification to refer to U.S. Patent No. 6,966,906 rather than the corresponding application serial number, and
- amending page 5 to correct the typographical error noted in item 1 on page 2 of the Official Action.

2. Objections to Drawings

These objections were addressed by the submission of formal drawings on May 24, 2006. It is noted that the substitute drawings include flowchart blocks, as required in the first sentence on page 3 of the Official Action.

3. Rejection Under 35 USC §112, 2nd Paragraph

This rejection has been addressed by amending claims 5-9 to recite the surgical instrument of claim 1. New claims 13-17 are identical to claims 5-9, but recite a surgical method and depend from method claim 3 rather than instrument claim 1.

4. Rejection of Claims 1 and 3 Under 35 USC §102(b) in view of U.S. Patent No. 5,662,585 (Willis)

This rejection has been rendered moot by the amendment of claims 1 and 3 to include the respective subject matter of original claims 2 and 4.

In particular, claims 1 and 3 now recite that the instrument forms a *urological coil* when raised to a temperature higher than a body temperature of the patient. The Willis patent discloses

a member that protrudes from an endoscope during angioplasty, and fails to disclose any sort of coil.

It is noted that claims 1 and 3 have been amended to delete the limitation that the temperature has to be raised by the irrigation fluid. The irrigation fluid limitation is found in claims 7 and 15. While use of irrigation fluid to raise the temperature of the shape memory alloy in order to form a coil is believed to be especially advantageous, use of other heating means may also be useful and should be included within the scope of the invention.

5. Rejection of Claims 1-3, 10, and 11 Under 35 USC §102(b) in view of U.S. Patent No. 4,503,569 (Dotter)

This rejection is respectfully traversed on the grounds that the Dotter patent fails to disclose or suggest a urological retrieval coil that assumes a coil shape upon heating to above body temperature. Instead, the Dotter patent is directed to a prosthesis that expands to become anchored in a blood vessel upon exposure to irrigation fluid of an appropriate temperature. Unlike the claimed coil, which assumes its coil shape following insertion into the patient, the coil of Dotter is already in a coil shape, as illustrated in Fig. 1, prior to insertion into the patient. As a result, it would be difficult to use the coil of Dotter as a urological coil, because a *urological* coil, as opposed to a vessel expanding prosthesis, should be as narrow as possible during insertion, so that it can be maneuvered past obstructions such as kidney stones.

Because the Dotter patent fails to disclose a urological coil, much less one that is bent into a coil *following* insertion into the patent, it is respectfully submitted that the Dotter patent does not anticipate or suggest the claimed invention, and withdrawal of the rejection of claims 1-3 under 35 USC §102(b) in view of the Dotter patent is respectfully requested.

6. Rejection of Claims 1-4, 10, and 11 Under 35 USC §102(e) in view of U.S. Patent No. 6,966,906 (Brown)

This rejection is respectfully traversed on the grounds that the Brown patent has the same inventive entity as the present application (Joe D. Brown of Panama City Beach, Florida), and


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therefore is not a proper reference under 35 USC §102(e), which requires that the prior patent be
“by another.”

Having thus overcome each of the rejections made in the Official Action, withdrawal of
the rejections and expedited passage of the application to issue is requested.

Respectfully submitted,

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